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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,280	06/27/2003	Jonathan N. Howarth	8568/7776	8295

7590 07/01/2005

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EXAMINER

HOEY, BETSEY MORRISON

ART UNIT PAPER NUMBER

1724

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/609,280

Applicant(s)

HOWARTH ET AL.

Examiner

Betsey M. Hoey

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-104 is/are pending in the application.
- 4a) Of the above claim(s) 93-98 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 6-16, 18-28, 30-41, 43-55 and 57-76 is/are allowed.
- 6) ☒ Claim(s) 5, 17, 29, 42, 56, 77-92 and 99-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-104 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/29/04, 8/13/04</u> | 6) <input type="checkbox"/> Other: _____ |

1. Claims 93-98 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 25, 2005.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 5, 17, 29, 42, 56, 77-92 and 99-104 are provisionally rejected under the judicially created doctrine of double patenting over claims of copending Application No. 10/843,030 and/or copending Application No. 10/912,949 as described below. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Instant claims 5, 17, 42, 77-82, 99 and 102 are rejected over claim 12 of Application No. 10/843,030 and claims 13 and 14 of Application No. 10/912,949

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because all of these claims recite a bromine-containing liquid, and . Instant claims 29, 56, 83-85, 100 and 103 are rejected over claim 37 of Application No. 10/843,030 and claims 26 and 27 of Application No. 10/912,949 because all of these claims recite a bromine- and chlorine-containing liquid. Instant claims 86-92, 101 and 104 are rejected over claims 49 and 50, or 62 or 64 and 65 of Application No. 10/843,030 because all of these claims recite a bromine-containing solid. It is submitted that according to MPEP §2113 [R-1] : *"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."* *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Therefore, even though the liquids and solids of the present and co-pending applications are made by different processes, because the products are the same, they are not patentably distinguishable from each other. It is also submitted that the intended use of the specific products do not patentably distinguish the products from each other. It is further submitted that the specific attributes of patentably indistinguishable products are considered to be inherent features of the products and therefore the attributes of same products in copending applications are considered to be inherently the same.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other

copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

4. Claims 1-4, 6-16, 18-28, 30-41, 43-55 and 57-76 allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Claims 1-4 are allowed because the prior art of record fails to teach, disclose, or fairly suggest a method of preparing a liquid, bromine-containing solution comprising combining a complexing agent, hydrogen peroxide, and anhydrous hydrogen bromide gas, and adding an alkaline source.

Claims 6-16 are allowed because the prior art of record fails to teach, disclose, or fairly suggest a method of preparing a liquid, bromine-containing solution comprising combining a source of bromide ions, hydrogen peroxide, and a complexing agent, and adding an alkaline source.

Claims 18-28 are allowed because the prior art of record fails to teach, disclose, or fairly suggest a method of preparing a liquid bromine- and chlorine-containing solution comprising combining a source of bromine ions, hydrogen peroxide and a complexing agent; adding an alkaline source and solid chlorinating agent; conducting solid-liquid separation; and adding a second alkaline source.

Claims 30-41 are allowed because the prior art of record fails to teach, disclose, or fairly suggest a method of preparing a liquid, bromine-containing solution comprising combining a source of bromide ions, a complexing agent, and a solid halogenating agent; conducting solid-liquid separation; and adding an alkaline source.

Claims 43-55 are allowed because the prior art of record fails to teach, disclose, or fairly suggest a method of preparing a liquid bromine- and chlorine-containing solution comprising combining a source of bromide ions, a complexing agent, and a solid chlorinating agent; conducting a solid-liquid separation; and adding an alkaline source.

Claims 57-64 are allowed because the prior art of record fails to teach, disclose, or fairly suggest a method of preparing a bromine-containing solid, comprising combining a bromine compound in the oxidation state of -1 , hydrogen peroxide, and a complexing agent; adding an alkaline source, and promoting crystallization of a bromine-containing solid.

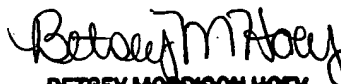
Claims 65-69 are allowed because the prior art of record fails to teach, disclose, or fairly suggest a method of preparing a bromine-containing solid in equilibrium with its saturated solution, comprising combining a bromine compound in the oxidation state of -1 , hydrogen peroxide, and a complexing agent; adding an alkaline source; promoting crystallization of a bromine-containing solid; and recovering a slurry of bromine-containing solid in equilibrium with its saturated solution.

Claims 70-74 are allowed because the prior art of record fails to teach, disclose, or fairly suggest a method of preparing a bromine-containing solid, comprising combining a source of bromide ions, a complexing agent, a first alkaline source, and a solid organic halogenating agent; conducting solid-liquid separation; adding a second alkaline source; and promoting crystallization of a bromine-containing solid.

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Claims 75 and 76 are allowed because the prior art of record fails to teach, disclose, or fairly suggest a method of preparing a bromine-containing solid in equilibrium with its saturated solution, comprising combining a source of bromide ions, a complexing agent, a first alkaline source, and a solid organic halogenating agent; conducting solid-liquid separation; adding a second alkaline source; promoting crystallization of a bromine-containing solid; and recovering a slurry of bromine-containing solid in equilibrium with its saturated solution.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betsey Hoey whose telephone number is **(571) 272-1158**. The examiner can normally be reached on Mondays, Tuesdays, and Thursdays. The examiner's supervisor, Mr. Duane Smith, may be reached at (571) 272-1166. Any inquiry of general nature may be directed to the Group receptionist at (571) 272-0987. The centralized fax number for the Group is (703) 872-9306. The examiner Rightfax number is (571) 273-1158.


BETSEY MORRISON HOEY
PRIMARY EXAMINER

June 26, 2005